

Remarks

The Office Action dated October 9, 2008 has been carefully considered. Claims 27-28, 30, 35-36, 38, 42-43 and 46-47 have been amended without the addition of new matter. Claims 31, 37, and 49-55 have been canceled. Reconsideration of the current claims is respectfully requested.

Statement Of The Substance Of The Interview

Attorney for Applicants thanks Examiner Kugel for the courtesies extended during the telephonic interview conducted on September 23, 2008. Attorney for Applicants generally agrees with the Interview Summary prepared by Examiner Kugel in connection with that telephonic interview and included with the October 9, 2008 Office Action.

Claim Rejections – 35 USC § 112

In Paragraph 5 of the Office Action, claims 27-50 and 53-55 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 27, 35 and 47 have been amended accordingly and claims 49-55 have been cancelled. Withdrawal of the claim rejections under 35 USC § 112 is respectfully requested.

Claim Rejections – 35 USC § 102 and/or 35 USC § 103

In Paragraph 6 of the Office Action, claims 27-31, 33-35, 37, 38, 41-45 and 47-55 are rejected under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a)

as being unpatentable over Muller '675. Reconsideration of the current claims in view of the amendments and following remarks is respectfully requested.

Claim 27 has been amended to the non-aqueous oil phase comprising paraffin's having from 5 to 22 carbon atoms wherein the non-aqueous oil phase contains at least about 50% by weight of component a), based on the weight of the oil phase. Support for this amendment can be found on page 12, lines 4-7 of the English translation of WO-A-029175, where it is stated that the oil phase is preferably formed by mixtures of components a) and/or b) with the ester oils c) in a weight ratio of from 10 : 1 to 1 : 1, which, in case only components a) and c) are used for the formation of the oil phase, would lead to a content of component a) of at least 50 % by weight. Such a composition containing 50 % by weight of a paraffin in the oil phase is also used in Example 3 of the present application.

Muller '675 does not disclose the use of paraffins in a drilling fluid or borehole treatment composition of the present invention. Muller '675 discloses the carboxylic esters, which corresponds to component c) of claim 27 as presently on file, which are used as one of the optional alternatives as the base material for the oil phase in the present invention. The oil phase disclosed in Muller '675 predominantly comprises carboxylic esters, but not paraffins having from 5 to 22 carbon atoms, as required by amended claim 27. Muller '675 does not disclose that the oil phase consist to at least 50 % by weight of a paraffin having 5 to 22 carbon atoms.

Muller '675 discloses that the carboxylic esters described therein may serve to form the base material of the oil phase and are furthermore known to have a low toxicity. There is also no reason for the person skilled in the art to add paraffins, which in contrast to carboxylic esters are

characterized by a significantly higher toxicity, in an amount of at least 50 % by weight to the non-aqueous oil phase.

It is respectfully submitted that claim 27 and also claims 28-48, all being dependent from claim 27, are therefore not anticipated by or unpatentable over Muller '675, and this rejection should be withdrawn.

In Paragraph 7 of the Office Action, claims 27-38 and 41-55 are rejected under 35 USC 102(e) as being anticipated by or, in the alternative, under 35 USC 103(a) as being unpatentable over US Patent Application Publication 2003/0144153 (Kirsner hereinafter). Reconsideration of the current claims in view of the amendments and following remarks is respectfully requested.

Kirsner discloses mixtures of internal olefins, corresponding to component b) of current claim 27, and carboxylic esters similar to component c) of current claim 27 as oil phases of invert emulsions for drilling fluids. Kirsner discloses in paragraphs [0067] to [0068] that such oil phases may further comprise paraffins. However, according to paragraph [0068] of Kirsner, the amount of paraffins should in this case be preferably less than 50 % by weight, whereas according to claim 27 as now amended the content of paraffin should be at least 50 % by weight.

As can be seen in the second table on page 5 of the English translation of WO-A-2004/029175 of the present invention, it has surprisingly been discovered that also in oil phases that are based to at least 50 % by weight on paraffins (the table lists compositions comprising 50 %, 60 %, and 70 % of a branched paraffin in combination with 50 %, 40 % and 30 % of the carboxylic ester) show a significantly reduced toxicity.

It is therefore respectfully submitted that claim 27 and also claims 28-48, all being dependent from claim 27, are therefore also not anticipated by or unpatentable over Kirsner and this rejection should be withdrawn.

In Paragraph 8 of the Office Action, claims 39 and 40 are rejected under 35 USC § 103(a) as being unpatentable over Muller '675 as applied to claims 27-31, 33-35, 37, 38, 41-45 and 47-55 above in view of US Patent 5,318,954 (Muller '954 hereinafter). Reconsideration of the current claims in view of the amendments and following remarks is respectfully requested.

Muller '954 does not disclose using paraffin as a base material for the oil phase, let alone in an amount of at least 50 % by weight, based on the weight of the oil-phase. A combination of Muller '954 and Muller '675 can not render the subject matter of claims 39 and 40, which are dependent from claim 27, obvious. Based on this, the rejection over Muller '954 should be withdrawn.

In Paragraph 9 of the Office Action, claims 39 and 40 are rejected under 35 USC § 103(a) as being unpatentable over Kirsner as applied to claims 27-38 and 41-55 above in view of Muller '954. Reconsideration of the current claims in view of the amendments and following remarks is respectfully requested.

As set forth above, Muller '954 does not disclose using paraffin as a base material for the oil phase, let alone in an amount of at least 50 % by weight, based on the weight of the oil-phase. The combination of Kirsner and Muller '954 does not disclose or suggest the subject matter of claims 39 and 40, which are dependent from claim 27. Hence, the rejection of claims 39 and 40 under 35 USC § 103(a) as being unpatentable over Kirsner as applied to claims 27-38 and 41-55 above in view of Muller '954 should be withdrawn.

Conclusion

In view of the amendments and remarks presented herein, Applicants submit that the present application is in condition for allowance, and such action is respectfully requested. If, however, any issues remain unresolved, the Examiner is invited to telephone Applicants' counsel at the number provided below.

Respectfully submitted,

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